

REMARKS

The above referenced application has been reviewed in light of the Office Action mailed September 18, 2008. Claims 1, 2, 5-17, and 20-26 are currently pending in this application with claims 1 and 15 being in independent form. Claims 1, 5, 8, 12, 14, and 15 have been amended by this response. Claims 23-26 have been added by this response. Amendments to the claims do not introduce new subject matter. In view of the amendments and the remarks to follow, allowance of this application is respectfully requested.

In the Office Action, claims 1-2, 5-14, and 21-22 were rejected under 35 U.S.C. §112, second paragraph. The Office states that claims 1, 5, 8, and 14 recite the limitation “the needle end” and it is unclear which needle end (the first or the second) is being claimed. Claim 1 recites a surgical needle which comprises, *inter alia*, an elongated needle body having a *first end* for attachment to a suture and a *second needle end* for penetrating tissue. Applicants have amended claims 1, 5, 8, 14, and 15 to consistently state the needle end as the second needle end. The Office also states that there is insufficient antecedent basis for the “the linear cutting edge” in claim 12. Claim 12 has been amended to correct this deficiency.

Claims 1, 2, 5-6, 8, 10, 12-17, and 21-22 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,002,564 to McGregor et al. (hereinafter, McGregor). Applicants respectfully submit that independent claims 1 and 15 are allowable over McGregor because McGregor fails to disclose each and every element of independent claims 1 and 15.

According to §2131 of the MPEP, to anticipate a claim, the reference must teach each and every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Independent claims 1 and 15 recite a surgical needle comprising, *inter alia*, an elongated needle body having a first end and a second needle end having a transition area, a proximal portion of the second needle end disposed proximally of the transition area including a first length having a trapezoidal transverse cross-section and a distal portion of the second needle end disposed distally of the transition area including a second length having a triangular transverse cross-section.

The cross-sections of the second needle end are shown in FIGS. 6 and 7, reproduced hereinbelow:

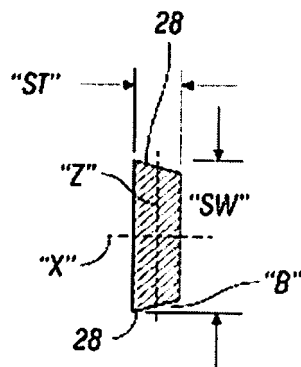


FIG. 6

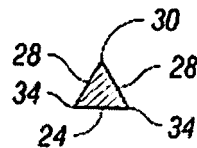
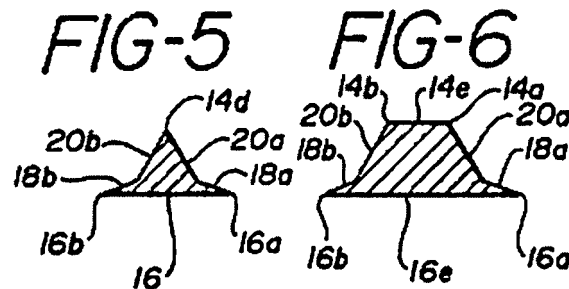


FIG. 7

The trapezoidal transverse cross-section is shown in Figure 6. A trapezoid is a quadrilateral plane having two parallel sides and two non-parallel sides. The triangular transverse cross-section is shown in Figure 7. A triangle is a closed plane figure having three sides and three angles.

McGregor discloses a surgical needle configuration with spatula geometry having a six-sided cross-sectional portion and a tapered end having a five-sided cross-section. The “six-sided cross-sectional portion results from a parallel or tapered pair of upper and lower surfaces connected by needle walls and a pair of fluted edges. At the tapered end of the needle, the upper surface alternates resulting in a five-sided cross-section.” (See Abstract of McGregor, lines 1-6.) The tapered end and the spatula area of the needle are shown in FIGS. 5 and 6, reproduced hereinbelow.



Applicants respectfully submit that McGregor fails to anticipate each and every element of claims 1 and 15, in that McGregor fails to show or disclose a proximal portion of the second needle end disposed proximally of the transition area including a first length having a trapezoidal transverse cross-section and a distal portion of the second needle end disposed distally of the transition area including a second length having a triangular transverse cross-section. The five- and six-sided needle of McGregor is neither triangular (three-sided) nor trapezoidal (four-sided).

Since McGregor does not disclose or suggest each and every element of claims 1 and 15, Applicants respectfully submit that the rejection of claims 1 and 15 as being anticipated under 35 U.S.C. §102(b) in view of McGregor should be withdrawn.

As claims 2, 5-6, 8, 10, 12-14, and 21-22 depend from claim 1 and contain all of the limitations recited therein, and claims 16-17 depend from claim 15 and contain all of the limitation recited therein, Applicants respectfully submit that claims 2, 5-6, 8, 10, 12-17, and 21-22 are also not anticipated under 35 U.S.C. §102(b) over McGregor.

Claims 7, 9, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over McGregor. As stated above, in respect to claims 1 and 15, McGregor fails to show or disclose a proximal portion of the second needle end disposed proximally of the transition area including a first length having a trapezoidal transverse cross-section and a distal portion of the second needle end disposed distally of the transition area including a second length having a triangular transverse cross-section.

Further, it would not be obvious to modify the needle geometry of McGregor. As stated above, McGregor discloses a surgical needle having a six-sided cross-sectional portion and a tapered end having a five-sided cross-section. "This improved configuration results in ease of tissue penetration, minimized tissue distortion, and minimized wound trauma." (See Abstract of McGregor, Lines 6-8.) The included angle of each of the fluted edges 18a and 18b, between the needle walls 20a and 20b, and at the point 14d created by the needle walls forming the five-sided cross-section improves tissue penetration of the needle as well as provides a smaller wound area. (See generally, Col. 3, lines 15-21.)

Moreover, McGregor states that triangular needles require refining:

Triangular shaped cross-section needles usually sacrifice one criterion for an increased benefit in another criterion. What is needed, therefore, is a needle with improved sharpness which also reduces penetration resistance, as well as reducing wound opening area and minimizing tissue distortion. With this

optimized needle cross-section, improved tissue apposition is possible, and highly refined surgery is generally more likely.

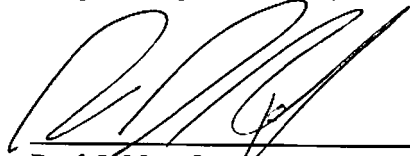
(McGregor, Col. 1, Lines 50-58.) McGregor, therefore, teaches away from using a three-sided triangular transverse cross-section as required by Applicants' claims.

Therefore, McGregor does not teach or suggest all of the claim limitations of claims 7 and 9 which depend from claim 1, and claim 20 which depends from claim 15. For at least this additional reason, Applicants believe that claims 7, 9, and 20 define over McGregor and are in condition for allowance. Therefore, Applicants respectfully submit that the rejection under 35 U.S.C. §103(a) has been overcome.

Claims 23-26 have been added by this response and further distinguish over the references of record.

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are in proper format and are patentably distinct from the references of record and are in condition for allowance. The Examiner is invited to contact the undersigned at the telephone number listed below with any questions concerning this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Paul J. Natof', is written over a horizontal line.

Paul J. Natof
Reg. No.: 54,333
Attorney for Applicants

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road - Suite 420
Melville, New York 11747
Tel.: (631) 501-5700
Fax: (631) 501-3526

Mailing Address:
Covidien
60 Middletown Avenue
North Haven, CT 06473